

DOCKET NO.: IVOO-0099  
Application No.: 09/476,078  
Office Action Dated: May 3, 2006

PATENT  
REPLY FILED UNDER EXPEDITED  
PROCEDURE PURSUANT TO  
37 CFR § 1.116



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
**Charles Eric Hunter**

Confirmation No.: **7280**

Application No.: **09/476,078**

Group Art Unit: **3621**

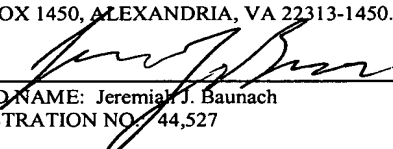
Filing Date: **December 30, 1999**

Examiner: **Calvin L. Hewitt, II**

For: **VIDEO AND MUSIC DISTRIBUTION SYSTEMS**

DATE OF DEPOSIT: June 30, 2006

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Sir:

**PRE-APPEAL REQUEST FOR REVIEW**

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

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**REMARKS – REASON FOR REVIEW**

Claims 1-28, 30, and 31 are pending in the present application, with claims 1, 10, 26, 27, 28, and 31 being the independent claims. Claims 1-28, 30 and 31 are rejected under 35 U.S.C. 103(a) as being allegedly being unpatentable over Schulhof et al., U.S. Patent No. 5,72,442 (Schulhof) in view of Neville et al., U.S. Patent No. 6,272,636 (Neville).

Review of the outstanding rejections to the claims is respectfully requested in view of the following remarks.

**Claim Rejections – 35 U.S.C. § 103**

Claims 1-28, 30 and 31 are rejected under 35 U.S.C. 103(a) as being allegedly being unpatentable over Schulhof et al., U.S. Patent No. 5,72,442 (Schulhof) in view of Neville et al., U.S. Patent No. 6,272,636 (Neville).

Claim 1 recites a particular way of initiating a purchase transaction that is not taught or suggested by Neville et al. or Schulhof, alone or in combination. In particular, claim 1 calls for:

...receiving unrestricted playback selection information regarding a previously recorded music selection from the at least one customer location to at a central controller system when the previously recorded music selection has been played a predetermined number of times at a customer location or an indication is made by the customer that the music is selected for unrestricted playback, whichever occurs first.

First, it is important to note that the withholding of an unlock key as described in Neville et al., to which the Office Action refers, is to prevent access to a “metered digital product” Col. 13, lines 14-26, and not to prevent access to any unrestricted use or playback. Essentially, the metered digital product of Neville, et al. is only available for use until the evaluation period has expired Col. 13, lines 30-35. The only language in Neville et al. that discusses unrestricted access to a digital product states “Essentially, a purchase step would remove any execution control features, and allow full execution of the product without limitation.” Col. 17, lines 3-5. However, this does not describe how the purchase is initiated

or completed. In contrast, claim 1 as recited above describes automatically receiving unrestricted playback selection information in a particular manner not described in Neville et al. or Schulhof.

Secondly, Neville et al. states that the “purchase step may be incorporated into the execution control procedures.” Col. 17, lines 1-2. However, this purchase step is after evaluation of software that has “execution control,” that “includes authorization to execute *at a remote clearinghouse site*, thereby preventing local, i.e., user, manipulation of a digital product.” Col. 16, lines 62-65. Claim 1 recites “previously recorded music selections, that were previously recorded by the at least one customer in a storage medium *at a location of the customer ...*” which is opposed to executing demo software at a remote clearinghouse. Thus, according to claim 1, the “previously recorded music selections” are stored at the “customer household,” rather than programs being executed or stored at a “remote clearinghouse site” as Neville et al. states.

In the response to arguments section of the 5/03/2006 Office Action, the Examiner states “Applicant is of the opinion that Neville does not teach storing ‘previously recorded content’” per se. However, as explained above and in the previous responses, this is incorrect as Applicant is of the opinion that Neville does not teach previously recorded music selections, that were previously recorded by the at least one customer in a storage medium *at a location of the customer ...*” Next, in the response to arguments section, Examiner addresses “permanent enabling code” limitations of dependent claims 8 and 19. However, nowhere in the Office Action does it appear the Examiner addresses the language below added to claim 1 in the 8/3/2005 amendment:

...when the previously recorded music selection has been  
played a predetermined number of times at a customer location  
or an indication is made by the customer that the music is  
selected for unrestricted playback, whichever occurs first.

Applicants submit that Schulhof et al. or Neville et al., taken alone or in combination, do not teach or suggest the limitation above from claim 1.

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Thus, for at least the reasons above, Applicant respectfully submits that all the limitations of claim 1 are not taught or suggested by Schulhof et al. or Neville et al.

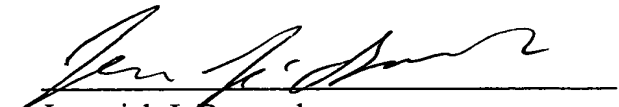
Regarding claims 2-18, 20, 21, 23, 26, 27 and 31, the Office Action gives the same reasons as for claim 1 in rejecting these claims. Thus, Applicant submits that all the limitations of claims 2-18, 20, 21, 23, 26, 27 and 31 are not taught or suggested by Schulhof et al. for at least the same reasons above as for claim 1 as amended.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2142. Since all the limitations of claims 1-28, 30 and 31 are not taught or suggested by Schulhof et al., Neville et al., or any combination thereof, for the same reasons presented above, withdrawal of the rejections under 35 U.S.C. § 103(a) for claims 1-28, 30 and 31 is earnestly solicited.

### **CONCLUSION**

Applicants believe that the remarks above are responsive to each point raised by the Examiner in the Office Action and Applicants submit that claims 1-28, 30, and 31 of the application are in condition for allowance. Should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative would very much appreciate a telephone conference to discuss these issues.

Date: June 30, 2006

  
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